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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Salton, Inc.

Serial No. 78197989

Samuel Fifer of Sonnenschein Nath & Rosenthal, LLP for
Salton, Inc.

Michael Webster, Trademark Examining Attorney, Law Office
102 (Thomas V. Shaw, Managing Attorney).

Before Quinn, Walters, and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 26, 2002, applicant Salton, Inc. filed an
intent-to-use application (No. 78197989) to register the
mark BEYOND, in standard character or typed form, on the
Principal Register for the following goods:

Electric household kitchen appliances, namely, ovens,
microwave ovens, convection ovens, toaster ovens,
toasters, grills, electric slow cookers, roasters,
coffee makers and bread makers; hand held electric
hair dryers, commercial and stationary hair dryers;
whirlpool baths for feet; heat and steam facial
saunas; portable electric water heaters and aerators
for washing and refreshing feet for domestic use;
parts and replacement parts therefor in International
Class 11.

The examining attorney has refused to register applicant's mark on the ground that the mark, if it were used on or in connection with the identified goods, so resembles the registered mark BEYOND as shown below:

BEYOND

for "retail store services in the field of linen products, housewares, and home furnishings" as to be likely to cause confusion, to cause mistake or to deceive. 15 U.S.C. § 1052(d).¹

When the refusal was made final, applicant filed a notice of appeal.

The examining attorney submitted a definition of the term "furnishings" as "the furniture, appliances, and other movable articles in a home or other building." The examining attorney also submitted evidence from what is apparently registrant's website that shows that the retailer Bed Bath & Beyond sells toasters, toaster ovens, slow cookers,² grills, coffee makers, bread makers, and hair

¹ Registration No. 2,003,965 issued October 1, 1996, renewed. The current owner is identified as Bed Bath & Beyond Procurement Co., Inc.

² We note that one of the slow cookers is a "Salton Rice Cooker."

dryers. These goods are identical to the goods for which applicant seeks registration. The examining attorney concludes that the "combination of the evidence and the dictionary definitions shows that the goods involved with registrant's retail services are clearly identical to the goods identified under Applicant's mark." Brief at 5. Furthermore, the examining attorney argues that the marks "are essentially identical" (Brief at 4) inasmuch as they are for the same word and the mark in applicant's drawing is not limited to any particular stylization.

Applicant submits that since "the term 'BEYOND' is weak, the cited mark deserves only a narrow scope of protection" (Brief at 3) and its "goods are sufficiently distinct from the services under the cited mark to preclude any realistic likelihood of confusion" (Brief at 6).

Preliminary Matters

Before we begin our analysis of the likelihood of confusion issue, it is necessary that we address several evidentiary matters. With its Reply Brief, applicant submitted numerous exhibits. Among the exhibits was a list of over one thousand applications and registrations containing the word "Beyond." The examining attorney "objects to any additional evidence because the record must be complete prior to the Appeal." Brief at 3. We agree.

It is too late at the appeal stage to submit additional evidence and, contrary to applicant's suggestion, we do not take judicial notice of USPTO registrations during an appeal. TBMP § 1208.04 (2d ed. rev. 2004). See also In re First Draft Inc., 76 USPQ2d 1183, 1192 (TTAB 2005)

("Submission of the TARR printout with its appeal brief, however, is an untimely submission of this evidence") and In re Carolina Apparel, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998) ("The Board does not take judicial notice of third-party registrations, and the mere listing of them is insufficient to make them of record"). Therefore, we will not consider any new registrations submitted with applicant's brief. However, we note that with its response dated December 19, 2003, applicant submitted a list of over 900 records containing the word "Beyond." Obviously, this list was submitted long prior to the appeal. Normally, applicant or the examining attorney must submit copies of the registrations and not just a list in order for the registrations to be considered. In re Duofold, Inc., 184 USPQ 638, 640 (TTAB 1974) ("[T]he submission of a list of registrations is insufficient to make them of record"). However, if an applicant submitted a list of registrations earlier in the prosecution and the examining attorney did not advise the applicant that a mere list was insufficient,

"the examining attorney will be deemed to have stipulated the registrations into the record." TBMP § 1208.02 (2d ed. rev. 2004). See also In re Hayes, 62 USPQ2d 1443, 1445 n.3 (TTAB 2003); In re Broyhill Furniture Industries Inc., 60 USPQ2d 1511, 1513 n.3 (TTAB 2001). In this case, applicant specifically mentioned the goods and services in several registrations and the examining attorney discussed them. Office Action dated February 10, 2004 at 3. Therefore, the earlier list of registrations that consists of the serial and registration number, the mark, and the "Live/Dead" status as well as the goods and services specified for the registrations discussed by the examining attorney and applicant are deemed to be of record. In re Total Quality Group, Inc., 51 USPQ2d 1474, 1477 n.6 (TTAB 1999) ("In the present case, however, the Examining Attorney did not raise any such objection, but rather considered the registrations as if they were properly made of record").³

Likelihood of Confusion

Under our long-established case law, when we have an issue of whether there is a likelihood of confusion under Section 2(d), we analyze the facts as they relate to the

³ We note that applicant's list includes trademark applications and these "applications, as opposed to registrations, have no probative value other than as evidence that the applications were filed." TBMP § 1208.02 (2d ed. rev. 2004).

relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin by looking at the similarities or dissimilarities of the marks. Here, the marks are for the same word BEYOND. The only difference between the marks is that registrant's mark is shown in a stylized form. However, applicant's mark is not limited to any particular display. "[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a *difference* cannot legally be asserted by that party. Tomy asserts rights in SQUIRT SQUAD regardless of type styles, proportions, or other possible variations. Thus, apart from the background design, the displays must

be considered the same." Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). Therefore, the marks BEYOND and BEYOND (stylized) must be considered the same and these marks are legally identical in sound, appearance, meaning, and commercial impression.⁴ In addition, we note that even if the stylization is considered, it is a minor feature of the registered mark and the word is clearly dominant. Accord CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) ("[M]inor design features do not necessarily obviate likelihood of confusion arising from consideration of the marks in their entireties. Moreover, in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed").

Next, we consider whether applicant's goods and registrant's services are related. Applicant's goods include: ovens, microwave ovens, convection ovens, toaster ovens, toasters, grills, electric slow cookers, roasters,

⁴ Applicant also argues (Brief at 7) that "any use of the word BEYOND in connection with BB&B would be instantly recognized as a shortened version of the mark BED BATH & BEYOND ... with the consumer filling in the remainder." However, we do not read limitations into the cited registration and we will not assume that purchasers would understand that there are additional words associated with the cited mark. Accord Squirtco v. Tomy Corp., 216 USPQ at 940.

coffee makers, bread makers, hair dryers, whirlpool baths for feet, heat and steam facial saunas, and portable electric water heaters and aerators for washing and refreshing feet for domestic use. The registered mark is used in association with retail store services in the field of linen products, housewares, and home furnishings. As indicated earlier, the examining attorney has included a definition of the term "furnishings" as "the furniture, appliances, and other movable articles in a home or other building." This definition would include many of the items that are set out in the application. In addition to this evidence, the examining attorney has also submitted evidence that registrant does sell numerous articles that are identical or virtually identical to the goods in the subject application. Thus, at least in part, registrant's services involve selling items that are identical or virtually identical to applicant's.

Thus, the question in this case is whether the goods and retail services involving the sale of the same goods are related. The Federal Circuit has addressed this issue in a similar case.

The only aspect of this case which is unusual is that the marks sought to be registered are for services while the prior registration on which their registration is refused is for wares. Considering the facts (a) that trademarks for goods find their

principal use in connection with *selling* the goods and (b) that the applicant's services are general merchandising -- that is to say *selling* -- services, we find this aspect of the case to be of little or no legal significance. The respective marks will have their only impact on the purchasing public in the same marketplace.

In re Hyper Shoppes (Ohio) Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (emphasis in original).

The services in the Hyper Shoppes case involved general merchandise store services. In the present case, registrant's retail store services are more directly related to applicant's goods than broad general merchandise services. Registrant's services specifically include the sale of housewares and home furnishings. Housewares and home furnishings would include many of the items in applicant's identification of goods.

When we consider the question of whether registrant's services and applicant's goods are related, it "has often been said that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used thereon, to a mistaken belief that they originate from

or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services." In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991). See also Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1661 (TTAB 2002).

Here, the question is whether prospective purchasers, when they encounter the same mark on coffee makers, slow cookers, toaster ovens, and similar products and on stores selling the same items, will assume that there is some association or relationship between the source of the goods and services. In this case, it is highly likely that many of these purchasers will assume that there is some relationship between the sources of these goods and services. Therefore, we determine that these goods and services are related.

At this point, we emphasize that we must compare the goods and services as they are identified in the application and registration. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what

the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed"). See also Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods" or services). While applicant asserts that "the kitchen and personal care appliances described in Applicant's application will be sold in conjunction with Applicant's sophisticated, cutting-edge BEYOND home network" (Reply Brief at 6), applicant's goods are not limited in this way. Therefore, we must consider applicant's goods to include all types of toaster ovens, coffee makers, slow cookers, and similar products.⁵

Applicant also argues (Reply Brief at 3) that "[s]ince the term 'BEYOND' is weak, the cited mark deserves only a

⁵ In its Reply Brief (p. 9), applicant, in the alternative, requested a remand to consider a new identification of goods. In his brief (p. 6), the examining attorney observed that he had "recommended that Applicant amend the identification of goods[.] Applicant made no attempt to distinguish the goods in the identification by amendment other than to delete the wording 'household,' which was an impermissible expansion of the scope of the goods." We deny applicant's belated request to remand the application. Not only is the request in the Reply Brief late, it is not clear if it would obviate the refusal. TBMP §§ 1205.01 and 1209.04 (2d ed. rev. 2004).

narrow scope of protection that does not reach applicant's mark." Applicant goes on to argue (Reply Brief at 4) that it has "submitted evidence to the Examining Attorney demonstrating that BEYOND is used in connection with a multitude of goods and services, and hence, the term is too weak and common to warrant a wide scope of protection." However, applicant's evidence consists primarily of a list of applications and registrations with only the mark specified. This list is entitled to little probative weight since the goods and services are not even identified.⁶ Secondly, even if the actual registrations were included, "third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they cannot be used to justify the registration of another confusingly similar mark." In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987). See also Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1742, 1745 (Fed. Cir. 1992):

As to strength of a mark, however, registration evidence may not be given any weight. AMF Inc. v. American Leisure Prods., Inc., 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973) (CCPA 1973) ("The

⁶ Moreover, for those registrations where the goods and services are identified in this record, such goods and services are not as similar to the services in the cited registration as are applicant's goods. See Response dated December 19, 2003 at 4-5 (vegetable oils, live musical performances, pre-recorded magnetic media, skin lotions, and retail store services involving AV and electronic equipment and laptops).

existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them....") (citations omitted).

Similarly, applicant's list of marks cannot be used to demonstrate that the registered mark is weak. We also add that even if the term "Beyond" was not entitled to a broad scope of protection, the scope of protection in this case is not broad. Applicant seeks registration for its mark for various appliances and it has been refused registration because of a cited registration for services that include selling those same items.

Applicant also points out that one of its applications "for BEYOND ('vacuum cleaners, carpet cleaning machines, floor cleaning machines') would also be covered by the Examining Attorney's all-encompassing definition of 'furnishings' - yet that application was allowed by the PTO." Reply Brief at 8. We fail to see the significance of this information. Each case must be decided on its own merits. In re Sunmarks Inc., 32 USPQ2d 1470, 1472 (TTAB 1994) (" Suffice it to say that each case must be decided on its own merits based on the evidence of record. We obviously are not privy to the record in the files of the registered marks and, in any event, the issuance of a registration(s) by an Examining Attorney cannot control the

result of another case"). Finally, the application (Serial No. 78197974) is now apparently abandoned.

When we consider the record, we conclude that when the marks BEYOND and BEYOND (stylized) would be used on or in association with the identified goods and services, confusion would be likely. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source").

Decision: The examining attorney's refusal to register applicant's mark BEYOND for the identified goods on the ground that it is likely to cause confusion with the cited registered mark is affirmed.